

Serial No. 09/558,920
In reply to the Office Action mailed April 20, 2006
Page 11 of 12

REMARKS

This is in response to the Office Action mailed on April 20, 2006. Claims 19-36 and 46-75 are pending in the application. Claims 46-75 are withdrawn from consideration. Claims 19-36 were rejected. With this response, no new claims are added and the pending claims are unchanged.

Claims 19-36 were rejected under 35 U.S.C. 102 or alternatively under 103. Specifically, the claims were rejected under 35 U.S.C. 102(b) as being anticipated by Quicken and its "Turbo Tax for the Web" and based upon public sale or use of the invention from the "TurboTax for the Web" and related documents. The Office Action stated that the TurboTax for the Web directly or inherently discloses all the claimed features. The Examiner made a factual determination in that "TurboTax for the Web" stores the taxpayer's return on secure servers and allows taxpayer to file electronically;" and another factual determination that "electronic receipts" and "automated messages in response to particular events" are "old and well known in the art." Still further, the claims were rejected under 35 U.S.C. 102(e) as being anticipated by Miller and TurboTax under MPEP 2131.01 III. The claims were also rejected under 35 U.S.C. 103(a) in view of "Turbo Tax for the Web" as an alternative to the rejections under 35 U.S.C. 102(b) and (e), in that the features would be obvious if they were not inherent.

Applicant respectfully submits that the claims are patentably distinguishable from the prior art of record, and has attempted to clarify and highlight these patentable distinctions in the claim amendments submitted on February 9, 2006. In response to the previous claim amendments, the Office Action states that "Applicant argues that the prior art does not disclose 'electronically storing a record of the filed tax return . . .' The Examiner respectfully disagrees since all databases store their information in records."

Applicant respectfully submits that the pending claims are distinguishable in more ways than simply the "electronically storing a record of the filed tax return." For example, the prior art of record does not show or suggest a combination set forth in the pending claims including "[1] electronically storing a record of the filed tax form in a government database ..., and [2] receiving from a user a request for the record of the filed tax form ... utilizing the network," that also includes "[3] authenticating an identity of user utilizing the network to request the record," and "[4] sending the record of the filed tax form to the user across the network to the client computer upon successful authentication of the identity of the user" along with the additional limitations of the claims. Simply put, the prior art does not teach or suggest storing a record with a government entity and then the government

Serial No. 09/558,920
In reply to the Office Action mailed April 20, 2006
Page 12 of 12

entity sending the record to a client computer upon a request from and successful authentication of the user (as distinct from filing the tax form) as these features are set forth in the claim. Instead, the Turbo Tax and the associated cited art teach sending a tax form to the Turbo Tax Electronic Filing Center where the tax form is submitted to the IRS. The Office Action argues that the "old and well known prior art" shows "an automated message in response to an event." The art does describe that Turbo Tax receives an IRS acknowledgement in response to the filing, but nothing in the art describes or suggests the claimed features highlighted in this paragraph in the language quoted above.

Upon consideration of these and other limitations in the combination, Applicant submits that it becomes clear that the highlighted limitations are not included or inherent in the TurboTax reference. Further, there is no suggestion in the prior art that the references be modified because the reference is complete in itself in sending an automated receipt in response to the filing.

Accordingly, Applicant respectfully submits that the prior art does not show or suggest the limitations of the pending claims. Applicant requests removal of the rejection and favorable action on and allowance of the application.

CONCLUSION

Applicants respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7340. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees, including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 60021-357601).

Respectfully submitted,

By

Rudolph P. Hofmann, Reg. No. 38,187
Customer No. 29338

Oppenheimer Wolff & Donnelly LLP
45 South Seventh Street, Suite 3300
Minneapolis, Minnesota 55402
Telephone: 612.607.7340
Facsimile: 612.607.7100
E-mail: RHofmann@Oppenheimer.com